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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,330	10/31/2003	Paul A. Kohl	062020-1540	2552

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EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/699,330	Applicant(s) KOHL ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 11-31 is/are pending in the application.
 4a) Of the above claim(s) 14-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9 and 11-13 with respect to the applied species is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-7,9 and 11-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>23 January 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

This is in response to Paper filed on 13 September 2004.

I. Applicants elect the invention of claims 1-7, 9 and 11-13 with traverse being acknowledged. The traversal is on the ground that there is no burden on searching one or more additional inventions. It is not found to be convincing since an additional search of one or more inventions as set forth on the record is burdensome.

II. Ms. Cynthia J. Lee confirm the election of species for their consistency on 13 October 2004 with:

B.1 as a positive tone sacrificial material (Claims 1-7, 9 and 11-13 as elected invention will be firstly considered and searched in class 430 subclass 270.1 as elected species),

2 and 4 as a polypropylene carbonate,

3 as tetrakis(pentafluorophenyl)borate-4-methylphenyl[4-(1-methyl)phenyl]iodonium

5 being not in the elected invention.

III. Claim 12 is contains the trademark/trade name "RhodosilTM".... Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves.

Art Unit: 1752

Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe material and, accordingly, the identification/description is indefinite.

IV. B. (1) It is allowed to claim by a functional, characteristic, conditional, physical and/or chemical property of a material and /or process. (2) However, a claimed functional, characteristic, conditional, physical and/or chemical property of a material and/or process carries with a risk (In re In re Schreiber, 44 USPQ2d 1432). It is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, conditional, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. Please also see the related issue with respect no patentable sense as stated in In re Hutchison, 69 USPQ 138. The language “nucleophilic halogenide”, “complex metal halide anion”, “the composition decomposes at a temperature range from...”, “the composition act as an adhesive”, “ the composition is a positive tone sacrificial material” or the like is considered as the functional and characteristic property of a material as searched appeared.

B. In re Schreiber, 44 USPQ2d 1429 states that “A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart... 169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in Swinehart... where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject mater

Art Unit: 1752

may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." A statement or argument alone may have and be given a little to no value because it is not factual evidence.

V. The record shows that applicants and their counsel fail to disclose to the Office a related application with its publication no. 2004/0132855.

VI. Applicants' prior art submission filed on 23 January 2004 has been considered.

VII. Applicants election of the species with traverse being acknowledged. The traversal is on the ground that there is no burden for searching for all of the species. Searching for more than a reasonable number of about five or more species is burdensome.

VIII. The elected species in paragraph "II" above have been considered and searched. The consideration and search are extended to the applied species. Others have not been considered, searched or examined until all of the applied species are overcome.

IX. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9 and 11-13 with respect to the applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Narang et al(Reference "O" as submitted).

Narang et al disclose, teach and suggest a composition comprising (1) polycarbonate being read within the broadly claimed polymer and (2) from 2% of diaryliodonium salts being read within the broadly claimed photoacid generator. The claims contain the properties of the material. They are reasonably considered as being inherent in the absence of convincing evidence to the contrary. Please especially see under "RESULTS AND DISCUSSION". Since Narang et al disclose, teach and suggest the requisite chemical ingredients of the claimed composition, it is reasonable that the claims would have the same or about the same properties as claimed. The law required that applicants show or provided convincing evidence to the contrary to speed up the prosecution and to avoid any later work for an inherency of the claimed properties since a claim would has no value if one later show or provide them from a pieces of a reference as clearly pointed out and set forth in paragraph "V" above because an argument alone may have and be given a little to no value.

X. Claims 1-7, 9 and 11-13 with respect to the applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsieh et al (5,587,224).

Hsieh et al disclose, teach and suggest a composition comprising (1) polycarbonate being read within the broadly claimed polymer and (2) photoacid generator being read within the broad claims. Please The claims contain the properties of the material. They are reasonably considered as being inherent in the absence of convincing evidence to the contrary. Please see the whole

Art Unit: 1752

disclosure or the applied reference, especially at col.24:41-43, 25:20-22, Example V, Table 1 Sample Nos. 1, 4, 5, 6, 7, 8, and 9; Example VI, Table 2 Sample No. 10. Since Narang et al disclose, teach and suggest the requisite chemical ingredients of the claimed composition, it is reasonable that the claims would have the same or about the same properties as claimed. The law required that applicants show or provided convincing evidence to the contrary to speed up the prosecution and to avoid any later work for an inherency of the claimed properties since a claim would has no value if one later show or provide them from a pieces of a reference as clearly pointed out and set forth in paragraph "V" above because an argument alone may have and be given a little to no value.

XI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:00 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1752

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
15 October 2004

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le